

REMARKS

Claims 1-6 are in the case. Of these, claims 3-6 were previously withdrawn from consideration and claims 1-2 were elected for prosecution. The examiner has rejected claims 1-2 and the Board of Patent Appeals and Interferences issued a decision affirming the examiner's position on August 3, 2009.

Claim Rejection – 35 USC § 103 (a) Obviousness

The examiner has rejected claims 1-2 as being unpatentable under 35 U.S.C. 103(a) over Mattiola et al. (4,881,375) in view of Niedwiecki et al. (6,755,225).

In the current application, there is one independent claim: claim 1 and one dependent claim: claim 2. Independent claim 1 defines a method for transfilling gas canisters on-site including the following limitations:

- a. transporting a transfilling station to a desired transfilling site;
- b. attaching gas canisters to said transfilling station;
- c. inspecting and evacuating said gas canisters;
- d. vaporizing and compressing a gas and directing it into said gas canisters;
- e. disconnecting said gas canisters; and
- f. transporting said transfilling station from said transfilling site.

Independent Claim 2 is as follows: The method of transfilling gas canisters on-site of claim 1 wherein said gas is medical oxygen.

As the examiner has correctly conceded, Mattiola fails to disclose at least one step of applicants' claim 1: transporting a transfilling station to and from a desired transfilling site. However, the examiner found that the combination of Mattiola with Niedwiecki would teach this transportation or mobility step. The applicants note the Board has affirmed the examiner's prima

facie case of obviousness. While the applicants respectfully disagree with the Board's position in this regard, the applicants hereby submit numerous secondary considerations as evidence of their invention's patentability. In view of the evidence presented below, the examiner is respectfully requested to reconsider his decision.

Secondary Considerations

In making a final determination of patentability, evidence supporting patentability must be weighed against evidence supporting a prima facie case of obviousness. When an applicant timely submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record. MPEP 716.01 (d). Affidavits or declarations, when timely presented, containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103. The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness."

In the present case, the examiner is respectfully requested to reconsider the invention's patentability in view of the following secondary considerations that are commensurate with the scope of the claimed invention and which support its patentability.

Long Felt But Unsatisfied Need in the Prior Art Recognized by Others/Inoperability of the Prior Art

Applicants' invention, as defined by claims 1 and 2, relates to a method of oxygen transfilling that is mobile and transportable. Prior to the development of applicants' method, medical equipment supply companies that delivered oxygen tanks/canisters to home patients faced substantial problems with regard to the re-filling of their oxygen canisters. These medical supply companies would have to coordinate and arrange for the transportation of numerous canisters to and from ground-based re-filling stations. These ground-based re-filling stations, in turn, not only took weeks to return the replenished canisters to the medical companies, but were also continually losing their canisters, costing the medical equipment supply companies thousands of dollars in operation and inventory losses. Even more problematically, the ground-based re-filling stations often mistakenly returned canisters to the wrong medical supply equipment company. Furthermore, in times of emergency situations, such as hurricanes, such ground-based re-filling stations often became flooded and/or lost power and thus became inoperable. In such scenarios, medical equipment supply companies, who needed re-filling of their canisters so that they could subsequently deliver them to home patients, were faced with a critical dilemma because they were unable to rely on the ground-based refilling stations.

And although, in the prior art, attempts were undertaken to resolve or alleviate the aforementioned problems, such as medical supply companies purchasing extra inventory, labeling their canisters to prevent loss or misplacement, and in general spending much time and effort to coordinate their operations with the schedules of ground-based re-filling stations, such attempts were largely unsuccessful. Thus, there existed a long-felt but unsatisfied need in the medical supply equipment industry for an invention that would greatly reduce and/or obviate the

above-discussed problems. During this time, the applicants' were employed by one such medical equipment supply company that was facing such issues. Recognizing the problems faced by their employer, the applicants' realized that the aforementioned problems could be obviated by creating a *mobile* transfilling station that was capable of being transported to the medical supply companies for *an on-site* re-filling. Thus, after a period of trial and error and extensive engineering, applicants developed a mobile transfilling station, comprising the necessary transfilling equipment, that met the stringent requirements of both the Food and Drug Administration, as well as the Department of Transportation. The applicants' subsequently formed C&M Oxyfill, LLC and began to provide their mobile transfilling services in 2004. The applicants' method began to experience significant success in the regions where it was introduced.

See **Attachment 1** – Declaration of Mr. Barry Blackbird, having over 31 years experience in the industry as a regional manager for a medical supply equipment company that is a current client of two licensees of applicants' that provide the mobile transfilling services. In his declaration, Mr. Blackbird attests to the long-felt but unsatisfied need for the invention, and further delineates how applicants' invention met this need. *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992) (Office personnel should consider declarations from those skilled in the art praising the claimed invention.)

Licensing/Replacement in the Industry of the Prior Art Methods by the Present Invention/Commercial Success

The applicants' method has currently achieved industry-wide acceptance and commercial success in the southern United States. The applicants have not ever conducted any type or form of advertising. They simply introduced their method into the marketplace several years back, and the advantages of their mobile transfilling method were soon observed and recognized by

third parties. In fact, a plethora of third parties approached applicants and obtained licenses to utilize applicants' method. Some of these companies include Purepoint, Inc, Air-eze, LLC, H&C Oxygen, Inc., P& J Oxyfill, LLC, and Quick-Fill Mobile Oxygen Inc. See **Attachment 2** – Declaration of applicant John Melvin, attesting to these third party licensees.

These companies in turn have achieved commercial success through their use of applicant's method. In fact, many of the aforementioned licensees have been so successful in their use of the applicants' mobile transfilling method, that they have driven numerous ground-based re-filling station competitors out of business. See **Attachment 3** – Declaration of Tim Ditmore of Quick-Fill Mobile Oxygen Inc., a licensee. Mr. Ditmore attests to the long-felt need in the industry, and the replacement in the industry of the prior art methods by the present invention. See also **Attachment 4** – Declaration of James Radcliff of P&J Oxyfill, LLC, a licensee. Mr. Radcliff attests to how weather conditions rendered ground-based re-filling stations inoperable during Hurricane Katrina and how the present invention fulfilled the needs of medical supply equipment companies during this time). *In re Tiffin*, 443 F.2d 344, 170 USPQ 88 (CCPA 1971) (fact that affidavit supporting contention of fulfillment of a long-felt need was sworn by a licensee adds to the weight to be accorded the affidavit, as long as there is a bona fide licensing agreement entered into at arm's length).

Conclusion

In summary, the examiner is respectfully requested to consider all the rebuttal arguments and evidence presented by applicants, to reconsider his decision, and to issue a Notice of Allowability. If the examiner believes a telephone conference will expedite the disposition of

this matter, the examiner is respectfully invited to contact this attorney at the number shown below.

Respectfully submitted:

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Sophia D. Alurkar
Reg. No. 56,182
ROY, KIESEL, KEEGAN & DENICOLA
2355 Drusilla Lane
P.O. Box 15928
Baton Rouge, LA 70895
(225) 927-9908